

REMARKS

In an Office Action mailed on September 18, 2009, claims 1-14 and 18-22 were rejected under 35 U.S.C. § 112, second paragraph; claims 1-5, 8-14, 21 and 22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Chehade; and claims 6, 7 and 18-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Chehade in view of Bhatt and Saito.

Regarding the § 112, second paragraph rejections, Applicant respectfully points out that it is improper to reject an independent claim based on a dependent claim, when the alleged deficiencies in the dependent claim do not affect the definiteness of the independent claim. Therefore, for at least this reason, withdrawal of the § 112, second paragraph rejections of claims 1-14, 18 and 19 is respectfully requested, in that the purported problems only appear to concern dependent claims 20-22.

Claims 21 and 22 have been amended to remove the language "among business processes" to overcome the corresponding § 112 rejections associated with these claims.

Regarding the § 112, second paragraph rejection of claim 20, the Examiner has failed to set forth a *prima facie* case of indefiniteness. In this manner, the § 112 rejection of claim 20 appears to be based on the purported failure of claim 20 to recite essential elements, as the Examiner rejects the claim due to the purported failure of claim 20 to recite what happens when a response is expected but not received. This particular case, however, is neither being claimed nor is required to be claimed by § 112, due to the failure of the Office Action to set forth a *prima facie* case of indefiniteness based on the failure to recite essential elements.

More specifically, section 2172.01 of the M.P.E.P. sets forth the standard for determining whether a claim is indefinite for failing to recite essential elements: "a claim which fails to interrelate essential elements of the invention *as defined by applicant(s) in the specification or other statements of record* may be rejected under 35 U.S.C. § 112, second paragraph for failure to point out and distinctly claim the invention." (*emphasis added*). Contrary to this standard, however, the Office Action fails to show where the specification or any other statement of record defines the omitted elements as being essential to the invention. In other words, no showing has been made to support a contention that Applicant deems the acts taken when a message is expected but not received as being essential. For at least the reason that the purported omission of essential elements appears to be the sole basis for the § 112, second paragraph rejection of

claim 20 and the Examiner has not set forth a *prima facie* case, Applicant respectfully requests withdrawal of the § 112 rejection of claim 21.

To clarify when a § 112, second paragraph rejection based on omitted essential matter is proper, section 2172.02 of the M.P.E.P. cites two cases: *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976) and *In re Collier*, 397 F.2d 1003, 158 USPQ 266 (CCPA 1968). In *In re Collier*, the applicant's claim recited limitations that were not positively claimed, and the applicant expressly admitted that the non-positively recited limitations were essential. As such, the court held that the applicant had failed to claim essential elements of the invention. *In re Collier* is distinguishable from the present application, however, for at least the reason that the Applicant in the present application has not admitted that the omitted matter is essential.

The court in *In re Venezia* held that the applicant had not failed to claim essential elements of the invention and distinguished *In re Collier* on the basis that in *In re Collier*, "the claim failed to comply with § 112, second paragraph 'in failing distinctly to claim what applicant in his brief insists is the actual invention.'" *In re Venezia*, 189 USPQ at 152. The court in *In re Venezia* also noted that unlike the applicant in *In re Collier*, "there is no issue in this case of whether applicant is claiming what he regards as his invention." Thus, similar to the facts of *In re Venezia*, the Applicant in the present application has not admitted that the omitted elements are essential.

Thus, in view of the foregoing, Applicant respectfully requests withdrawal of the § 112, second paragraph rejections of claims 1-14 and 18-22.

Regarding the § 103 rejections, to make a determination under 35 U.S.C. § 103, several basic factual inquiries must be performed, including determining the scope and content of the prior art, and ascertaining the differences between the prior art and the claims at issue. *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 U.S.P.Q. 459 (1965). Moreover, as the U.S. Supreme Court held, it is important to identify a reason that would have prompted a person of ordinary skill in the art to combine reference teachings in the manner that the claimed invention does. *KSR International Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1741, 82 U.S.P.Q.2d 1385 (2007).

As amended, the method of independent claim 1 now recites receiving a message from the internal business partner of the first trading partner and automatically converting the message into a corresponding message having the communication format specified by an interaction standard for communication to a second trading partner using the interaction standard.

Contrary to the limitations of amended independent claim 1, Chehade fails to disclose or render obvious the conversion of messages in a particular trading partner. In this manner, Chehade instead discloses a process manager 320 that performs message translations between trading partners. However, the process manager 320 is an intermediary between trading partners and as such, has additional complexities in that the process manager 320 must recognize and track the different message protocols and formats used by the trading partners. To the contrary, the arrangement that is now set forth in independent claim 1 is internal to the trading partner, and as such, has a significantly reduced complexity in that the format and data standards inside the trading partner are known, and the format may be translated into a more uniform interaction standard that is recognized by the second trading partner and possibly other trading partners. Thus, not only does Chehade fail to disclose the additional limitations that are now recited in claim 1, the advantages that flow from the method of claim 1 cannot be achieved using Chehade's system.

In the § 103 rejection of claim 1, the Examiner contends that it would have been purportedly obvious to one of ordinary skill in the art to combine the process manager 320 and one of the trading partners of Chehade due to a *per se* rule that forming one piece in an article which is formally been formed in two pieces purportedly only involves routine skill in the art. Office Action, p. 5. The Examiner's analysis, however, cites relatively old case law, which has been clarified in a more recent decision. The Federal Circuit has more recently held that there are no *per se* rules of obviousness, as such rules that improperly eliminate the need for fact specific analysis of claims and art, and the Federal Circuit has held that applying such *per se* rules of obviousness without such analyses is therefore legally incorrect. *In re Ochiai*, 37 USPQ 2d., 1127, 1133 (Fed. Cir. 1995). Thus, it is improper to merely rely on a *per se* rule of obviousness, such as a rule that it is purportedly obvious to combine two pieces into one.

Thus, in view of the foregoing, Applicant respectfully requests withdrawal of the § 103 rejection of independent claim 1.

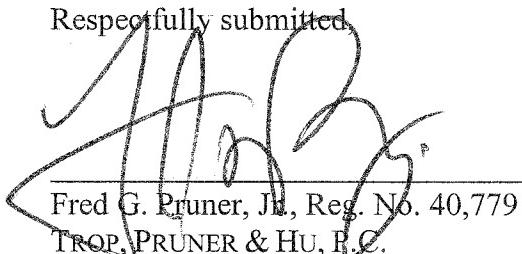
For similar reasons, Applicant respectfully requests withdrawal of the § 103 rejection of independent claim 8, which has been amended to recite a trading partner conversation manager of a first trading partner, which manages conversation between an internal business process of the first trading partner and a second trading partner.

Dependent claims 1-7 and 9-14 and 18-22 overcome the § 103 rejections for at least the same reasons as the claims from which they depend.

CONCLUSION

In view of the foregoing, withdrawal of the §§ 112 and 103 rejections and a favorable action in the form of a Notice of Allowance are requested. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 08-2025, under Order No. 10010317-1.

Respectfully submitted,



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